

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 46

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES C. LETTON and ROBERT D. FEENEY

Appeal No. 95-0459
Application 07/941,845¹

ON BRIEF

Before WINTERS, WILLIAM F. SMITH, and LIEBERMAN,
Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 of claims 2

¹ Application for patent filed September 8, 1992.
According to appellants, this application is a continuation of
Application 07/709,074, filed May 30, 1991; which is a
continuation of Application 07/417,385, filed October 5, 1989;
which is a continuation-in-part of Application 07/036,738,
filed April 10, 1987, now abandoned.

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through 11 and 13 through 25, as amended after the final rejection. See the amendment dated November 3, 1993 (Paper No. 29) and the advisory action dated November 26, 1993 (Paper No. 32).

THE INVENTION

Appellants' invention is directed to sucrose polyesters(SPE's) of mixed fatty acids having both short carbon chain lengths of about 4 to about 12 carbon atoms and long carbon chain lengths from about 20 to about 24 carbon atoms. The invention requires specific mole ratios of short chain to long chain radicals, and a degree of esterification of from about 7 to about 8. The sucrose polyesters have a minimum melting point of 47° C. The invention is further directed to food compositions which contain a non-digestible oil and the aforementioned sucrose polyesters.

THE CLAIMS

Claims 24 and 25 are illustrative of appellants' invention and are reproduced below;

24. A fatty acid ester of sucrose, the fatty acid groups consisting essentially of short chain saturated straight chain fatty acid radicals containing from about 4 to about 12 carbon

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atoms and long chain saturated straight chain fatty acid radicals containing from about 20 to about 24 carbon atoms, the molar ratio of short chain to long chain radicals being from about 2:6 to 4:4, the degree of esterification being from about 7 to about 8 and the melting point being at least 47EC, provided however, when the short chain radical is C₁₂ the long chain radical is C₂₂.

25. A food composition comprising:

a) a nondigestible oil having a melting point below 37EC, and
b) A fatty acid ester of sucrose, the fatty acid groups consisting essentially of short chain saturated straight chain fatty acid radicals containing from about 2 to about 12 carbon atoms and long chain saturated straight chain fatty acid radicals containing from about 20 to about 24 carbon atoms, the molar ratio of short chain to long chain radicals being from about 2:6 to 4:4, the degree of esterification being from about 7 to about 8 and the melting point being at least 47EC, provided however, when the short chain radical is C₁₂ the long chain radical is C₂₂;

wherein the weight ratio of a) to b) in said composition is from 9:1 to 4:1 so as to prevent the anal leakage problem associated with the ingestion of the nondigestible oil.

THE REFERENCES OF RECORD

As evidence of unpatentability, the examiner relies upon the following references of record.

Eckey et al. (Eckey)	3,093,481	Jun. 11, 1963
Baur et al. (Baur)	3,158,490	Nov. 24, 1964
Jandacek	4,005,195	Jan. 25, 1977

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THE REJECTIONS

Claims 2 through 11 and 24 stand rejected under 35
U.S.C.

§ 102(b) as anticipated by or, in the alternative, under 35
U.S.C. § 103 as being obvious over Baur or Eckey.

Claims 13 through 23 and 25 stand rejected under 35
U.S.C. § 103 as being unpatentable over Baur or Eckey in view
of Jandacek.

OPINION

We have carefully considered all of the arguments
advanced by appellants and the examiner and agree with
appellants that the aforementioned rejections are not well
founded. Accordingly, we will not sustain the rejections.

The § 102(b) Rejections

As to the rejection of the appealed claims under 35
U.S.C. § 102(b), appellants argue that Baur and Eckey,
"encompass a myriad of SPE's having combinations of long and
short chain ester groups and different degrees of
esterification. None of the SPE's specifically disclosed in

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these references meet all of the criteria specified in Appellants' Claims". See Brief, page 7. We agree. Although the examiner states that the sucrose polyesters are anticipated by Baur or Eckey and relies upon Baur, column 2, lines 4-20 and Eckey, column 2, lines 24-54, we have determined that each of the references is replete with teachings which fall outside the scope of the claimed subject matter.

We find that the SPE's of Baur utilize long chain saturated fatty acids of 14 to 22 carbon atoms, as compared with 20 to 24 carbon atoms of the claimed subject matter. We further find the remainder of the fatty acids present in the SPE's may contain up to 85% unsaturated fatty acids having from 14 to 22 carbon atoms. See Baur, column 1, lines 66-69. In contrast, unsaturated fatty acids are not contemplated by appellants claimed subject matter. Furthermore, Baur contemplates a minimum of only 3 esterified groups as compared with a minimum of about 7 in the claimed subject matter. See Baur, column 1, line 59 through column 2, line 20. Moreover, there is no contemplation of the melting point limitation of 47° C required by the claimed subject matter.

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As to Eckey, a similar analysis applies. See Eckey, column 2, lines 26 through 53. We find a comparable disclosure of long chain saturated and unsaturated fatty acids having 14 to 22 carbon atoms. See Eckey, column 2, lines 37-52. Eckey requires half of the hydroxyl groups of the carbohydrate (sucrose) to be esterified with the above mentioned saturated fatty acid. The balance however, can additionally be esterified with unsaturated fatty acid or short chain fatty acid. Furthermore, we find that none of the examples in either of the references fall within the scope of the claimed subject matter.

Based upon the above teachings we cannot agree with the examiner that the claimed invention is anticipated by either Baur or Eckey. In order to arrive at the claimed subject matter, a person having ordinary skill in the art would have to carefully pick and choose and combine various disclosures among the teachings of both Baur and Eckey. Accordingly, none of the disclosure of either patent relied upon by the examiner can be said to constitute subject matter which is substantially identical to appellants' invention. See In re

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Arkley, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972). Nor can it be said that the prior art has disclosed a composition substantially identical with the claimed invention. See In re Schaumann, 572 F.2d 312, 317, 197 USPQ 5, 10 (CCPA 1978).

Hence, we shall not sustain either of the rejections on the grounds of anticipation.

The § 103 rejections

Notwithstanding our finding supra, it should be noted that rejections under 35 U.S.C. § 103 may be appropriate and proper where the subject matter claimed is not identically disclosed or described. Accordingly, we shall next consider the rejection of the claims over Baur or Eckey under 35 U.S.C. § 103 and the rejection of Baur or Eckey in view of Jandacek under 35 U.S.C. § 103.

Assuming *arguendo* that it would have been *prima facie* obvious for one of ordinary skill in the art to prepare appellants' claimed subject matter, it is necessary for us to consider appellants' rebuttal evidence. Appellants urge that they have presented objective evidence wherein the claimed

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SPE's have been demonstrated to be unobvious over the broad disclosure of SPE's, and the closest SPE's exemplified in Baur and Eckey. See Brief, page 9. We agree. We find the evidence submitted by appellants in the Declarations of Timothy B. Guffey, to be dispositive of the remaining issues before us.

Appellants have submitted two Declarations of Timothy Guffey wherein three SPE's made according to the claimed subject matter were compared with three examples of Baur and one example of Eckey. The examiner in his Answer responded by focusing on the differences in stability and viscosity between Example 1 of Eckey drawn to sucrose stearate and its comparison with appellants' C12:C22 SPE, these two examples being closest in terms of the abovementioned parameters. It is the examiner's position that "[s]uch differences in results are seen to be minor." However, no rationale in support of this position was presented in the Answer. See Answer, page 5.

Referring to pages 4 and 5 of the Guffey Declaration i.e., Appendix B, we find the difference in stability and viscosity between appellants' C12:C22 and Example 1 of Eckey

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to be unusual and unexpected, particularly as the distinction in both properties arise from the choice of particular homologs of long chain saturated fatty acids in particular mole ratios, and the omission of unsaturated long chain fatty acids. We find this comparison of the closest example of the prior art with the closest example of appellants' claimed subject matter, which results in an 18% increase in stability coupled with substantially more than a doubling of the viscosity for appellants' composition, to be both unusual and unexpected. Moreover, in view of the Answer's failure to challenge Declarants' conclusion that the viscosities achieved by his invention are non-pourable as compared to Eckey's pourable composition, we are constrained to agree with the conclusions reached by Declarant. See the Guffey Declaration, Appendix B, page 5.

For the above reasons, we conclude, evaluating the examiner's *prima facie* case of obviousness in view of appellants' evidence and arguments, that based on the totality of the record before us, the preponderance of evidence weighs in favor of non-

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obviousness within the meaning of § 103. In re Oetiker, 977
F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

DECISION

The rejection of claims 2 through 11 and 24 under 35
U.S.C. § 102(b) as anticipated by or, in the alternative,
under 35 U.S.C. § 103 as being obvious over Baur or Eckey is
reversed.

The rejection of claims 13 through 23 and 25 under 35
U.S.C. § 103 as being unpatentable over Baur or Eckey in view
of Jandacek is reversed.

The decision of the examiner is reversed.

REVERSED

	Sherman D. Winters)	
	Administrative Patent Judge)	
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)	
	William F. Smith)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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Paul Lieberman)
Administrative Patent Judge)

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